

REMARKS

Applicants note initially that the December Action is nearly identical to the April Action with two exceptions. First, the Croft reference (United States Patent No. “USPN” 5,893,459) replaces Adolf (USPN 5,514,123) in the combination of references asserted to reject claims 9-14, 16-22, and 25-32 under 35 U.S.C. § 103(a). Second, the Fuji reference (USPN 4,311,810) replaces Ding (USPN 6,297,322) in the combination of references asserted to reject claims 12-13, also under § 103(a). What has not changed is the Examiner’s reliance on Heiden (USPN 6,408,286), in various combination with other references, to reject all of Applicants’ claims.

I. Because Heiden is Directed to Brokering Advertising Space on Envelopes Using a Postage Printing System, Heiden is Not Within an Analogous Art and Thus Cannot Form the Basis of a § 103(a) Rejection.

In their Reply to the April Action, Applicants argued that Heiden cannot be relied upon to reject Applicants’ claims under § 103(a) because Heiden is not within an analogous art. That is, Heiden is neither within Applicants’ field of endeavor nor reasonably pertinent to the particular problem with which they were concerned. *See* Reply to the April Action at pp. 13-16; *see also* MPEP § 2141.01(a). In the December Action, the Examiner responded that Heiden is within an analogous art because:

the Heiden reference relates to an indicia that represents information about an item, and similarly a bar code or any other kind of identification indicia also represents information about an item.

(December Action at p. 8).

Because this statement does not relate to the respective problems solved by Heiden and Applicants, then the Examiner must believe that Heiden is within Applicants’ field of endeavor. The same field of endeavor, however, is not established merely because a bar code or indicia is

disclosed in both references. On this point, *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992), is instructive.

In *Clay*, the applicant's claims related to a process for storing a refined, liquid hydrocarbon product in a tank having a dead volume between the tank bottom and its outlet port. The dead volume was filled with a gelatin solution that prevented loss and contamination of the stored product. The PTO rejected the claims under § 103 in view of two references. The first reference disclosed an apparatus for displacing dead volume with an impervious bladder. The second reference disclosed a process for reducing the permeability of natural, underground hydrocarbon formations using a gel similar to the applicant's. The applicant subsequently argued unsuccessfully to the PTO and then the BPAI that the second reference was not analogous prior art. *Id.* at 658.

The Federal Circuit reversed, however, holding that the second reference "cannot be considered to be within [applicant's] field of endeavor merely because both relate to the petroleum industry." *Id.* at 659. What supported its holding was that the second reference taught the use of the gel in a different structure (underground vs. a storage tank) and under different temperature and pressure conditions. *Id.* The Federal Circuit thus reasoned that the second reference's field of endeavor was *extracting* crude petroleum while the applicant's was *storing* refined hydrocarbons. *Id.*

As petroleum was common subject matter between the asserted reference and the claims at issue in *Clay*, a bar code is common to Heiden and Applicants' claimed invention. But, as *Clay* advises, this alone does not qualify Heiden as within an analogous art. Further, Heiden teaches a bar code on a different structure than claimed by Applicants – in a postal indicium on

an envelope, as opposed to on a container that defines part of the code. Moreover, even Heiden does not characterize its field as relating to “an indicia that represents information.”

Heiden states instead that its field is “postage printing systems” (1:24-25) and that the system brokers advertising space on envelopes (3:20-22), which “improves the ability of third party advertisers [to] more efficiently reach their target audience through advertising on envelopes” (10:1-3). Thus, as the divergent fields in *Clay* were the extracting and storing of petroleum, the divergent fields here are Heiden’s *brokering* of advertising space on envelopes using a postage printing system (which may include a postal indicium with a bar code¹) and Applicants’ *encoding* of information on an article where the article itself forms part of a bar code.

Further, the Examiner’s characterization of Heiden’s field is incorrect for two reasons. First, such reasoning results in a *limitless* prior art in view of the countless patents that minimally disclose a bar code, as well as the nearly infinite number of products that are labeled with – but wholly unrelated to – bar codes.² *See also* MPEP §§ 2141, 2141.01 and 2141.01(a) (advising that the scope of the prior art must have defined boundaries when determining obviousness).

Second, and contrary to MPEP §§ 2141 and 2141.02, such reasoning fails to consider Heiden as a whole. Again, Heiden relates to brokering advertising space on envelopes using a postage printing system. That the postal indicium printed by the system may include a bar code

¹ Heiden discloses that “any format” of data representation, including but not limited to, a bar code may represent the variable information in the indicium (5:32-34).

² Applicants do not suggest that their field of endeavor is bar codes in general. Rather, their field of endeavor is defined by the specification, which includes disjunctively and without limitation, an article of manufacture having a bar code where the article itself forms part of the bar code, where such an article may be flexible, where the article may be a medical container, where a bar code comprises variable information, and where the code may be a negative or positive image.

simply does not place Heiden – when considered as a whole – within Applicants’ field of endeavor.

II. A Prima Facie Case of Obviousness Has Not Been Established Because the Asserted Prior Art Combinations Fail to Teach a Container with a Bar Code Where the Container Forms Part of the Bar Code.

Even if Heiden were within an analogous art, a *prima facie* case of obviousness has not been established because the asserted combinations fail to teach or suggest all of Applicants’ claim limitations. See MPEP § 2143. To illustrate, the primary combination on which the examiner relies is Takada and Heiden.³ With respect to Applicants’ amended claim 1, this combination fails to teach the limitation of a container “wherein the container defines spaces that separate the light-reflecting segments.”⁴ As recited in claim 1, the spaces define light-absorbing segments that, together with the light-reflecting segments, “define a negative image bar code representing fixed information and variable information.” In other words, the combination of Takada and Heiden fail to teach a container having a bar code where the container forms part of the code.⁵

What the combination teaches, instead, is a bar code that is first formed on a suitable substrate and then applied to the article that will contain the code. For example, Takada teaches a card having a retroreflective bar code where the code is formed:

³ Though Takada and Heiden were combined with at least one other reference to reject the majority of Applicants’ claims, claims 1, 2, 6 and 15 were rejected in view of this combination alone (December Action at p. 2).

⁴ Where to find in the original specification the support for each amendment is discussed *infra*.

⁵ The combination also fails to teach a bar code comprising fixed and variable information, as only the variable data of the postal indicium in Heiden may be represented by a bar code (5:29-34). Representation of the fixed data is limited to a graphic design, meter serial number, or a post office identifier (5:14-17).

with black bars (or white bars) of [the] bar code printed on a prior art sheet of paper [where the retroflective material is] stuck to a base plate [or alternatively where the] transparent stripes and opaque stripes are formed so as to form a bar code stuck to a sheet formed of a sheet of retroflective material.

(1:55-2:7) (emphasis added).

According to this disclosure, a bar code is first formed on paper or on a retroflective sheet. After being formed, the bar code may then be applied to the article (a card in Takada's case) that will contain the code.

To further illustrate, the Examiner specifically cited Figure 4 of Takada as teaching a bar code on a substrate (December Action at p. 2). To form the bar code of that figure, Takada discloses that:

retroreflective material 29 is stuck to a bright portion 28a on the card substrate 28. The bright portion 28a reflects light incident thereon. A dark portion 28b of the card substrate 28 is left unchanged because it is not needed to reflect incident light. The dark portion 28b can be formed by a printing process of black color having a light absorption property or the like. The retroreflective material 29 is formed by depositing a number of very small glass beads 29a on a mount 29b made of paper.

(5:39-49) (emphasis added).

Takada thus teaches that to form the bar code, the dark (light-absorbing) portion of the code must first be printed. The dark portion is then combined with the retroflective material to form the bar code, meaning that the card itself does not form part of the code. Thus, the combination of Takada and Heiden fails to teach a container having a bar code where the container forms part of the code, particularly where the code represents variable information, as recited in Applicants' claim 1. For at least this reason, a *prima facie* case of obviousness has not been established.

Because every independent claim (as amended or new) recites a similar limitation that the article of manufacture (*e.g.*, container, medical container, web, film or etc.) having the bar code forms part of the code, because every dependent claim will necessarily include that limitation,⁶ and because Takada and Heiden is the primary combination used to reject all the pending claims, Applicants respectfully submit that a *prima facie* case of obviousness has not been established as to any pending claim. *See, e.g.*, MPEP §2143.03 (advising that any claim that depends from a nonobvious claim is also nonobvious).

III. Because the Combination of Takada and Heiden Suggests a Code Having Only Fixed Information, and Thus Teaches Away from Applicants' Invention, and Because the Motivation to Combine Those References is Found Only in Applicants' Disclosure, a Prima Facie Case of Obviousness Has Not Been Established.

In their Reply to the April Action, Applicants argued that the combination of Takada and Heiden could not support a *prima facie* case of obviousness because (1) there is no reasonable expectation of success in the combination, and because (2) there is no source for the motivation to combine the references other than Applicants' disclosure. Together with the requirement that the combination must teach all of the claim limitations, these criteria must be met to establish a *prima facie* case of obviousness. *See* MPEP § 2143.

The December Action, however, did not respond to Applicants' argument that there is no reasonable expectation of success in the combination of Takeda and Heiden because it *teaches away* from the claimed invention. *See* Reply to April Action at pp. 17-18; *see also* MPEP § 2141.02 (stating a reference must be considered for what it teaches away from a claimed invention). For example, Takada forms a bar code by selectively heating, distorting and crushing

⁶ Each claim also recites a bar code comprising variable information.

(10:10-11) “glass beads, plastic beads or the like” (11:61-62). This process affords a bar code where “the life span of the information recorded [in the bar code] is long” (3:12-14; *see also* 12:10-11). Thus, if a bar code is formed by heating, distorting and crushing its essential elements, then there is no reasonable expectation of success for such a bar code to contain the variable information disclosed in Heiden. Such a bar code simply is not suited for information that is apt to change.

With regard to the source of the motivation to combine Takada and Heiden, the Examiner responded that the “common aspects about the two references,” such as “[teaching] indicia for identifying an item,” lead the Examiner to combine the references (December Action at p. 9). Applicants understand this statement to mean that the Examiner believes that the source for the motivation to combine the references is their teachings. *See, e.g.* MPEP § 2143.01 (stating that the source of motivation must come from such teachings, the nature of the problem to be solved, or the knowledge of one of ordinary skill). One problem with the “common aspects” theory, though, is that it permits a reference to be combined with any other reference(s), so long as common subject matter is tangentially disclosed, without regard to the specific teachings of the references.

As argued above, Heiden teaches virtually nothing about indicia for identifying an item. Heiden does teach that “any format,” and not just a bar code, may represent the variable information in a postal indicium (5:32-34). The Examiner combines that *de minimus* disclosure with Takada’s disclosure of a reverse image bar code to reject Applicants’ claimed invention. As shown above, though, Takada’s bar code can reasonably contain only fixed information. Because the teachings of Takada and Heiden thus do not contain the requisite suggestion or motivation for their combination, the modification could have been suggested only by

Applicants' disclosure. Applicants thus respectfully submit that a *prima facie* case of obviousness has not been made with respect to any claim.

IV. Each Amendment is Supported by the Original Specification.

Applicants aver that each amendment in the above-listing of claims is supported by their original specification. For the Examiner's guidance, Applicants offer below a non-exhaustive identification of where in the original specification such support is found. Because of the non-exhaustive nature of this exercise, Applicants respectfully reserve the right to identify additional examples within the specification where adequate support is found should the Examiner have any question in this regard. Of course, the Examiner is invited to call the undersigned in such a case.

That the container may be a medical container is supported by at least 1:3-6, 1:19-26, and 8:28-32.

That the substrate (*e.g.*, container, medical container, web, film or etc.) defines spaces that separate the light-reflecting segments is supported by at least Figures 1-3, original claims 1-32, 4:37-5:2, 6:22-28, 7:33-40, 9:8-12, 10:4-10, 11:10-17, and 12:18-31.

That the substrate may be flexible is supported by at least original claim 14, 1:3-6, 1:14-19, 4:1-5, and 8:31-34.

That the bar code has a portion that has an A or B scan grade when decoded through a material and in accordance with ANSI X3.182 is supported by at least 3:13-17, 3:36-40, 13:5-19, 21:9-22:2, Tables 5 and 8-11, and Figure 3.

That the bar code comprises a symbology selected from the group consisting of Code 16K, Code 39, Code 49, Codabar, Code 128, UPC-E, UPC-A, EAN-8, EAN-13, Reduced Space

Symbology, composite symbol, PDF-417, Interleaved 2-of-5, and a two-dimensional symbology is supported by at least Figure 5 and 8:24-26.

That the bar code has length of less than 72 millimeters, less than or equal to 52 millimeters, or less than or equal to 22 millimeters is supported by at least 15:4-14, 16:10-15, 17:9-10, 18:1-3, 20:12-23, 21:9-10, and Tables 2-5 and 8-11.

That the material is an overpouch comprising polyethylene and has a thickness of at least 2 to 8 mils is supported by at least 3:33-40, 5:26-28, 9:14-35, 10:36-37, 11:30-32, 13:11-14, 13:27-28, 14:6, 18:25-26, Tables 1 and 9-11, and Figure 3.

That the substrate has a maximum reflectance of about twenty-five percent is supported by at least 7:4-20, 8:13-18, 9:28-33, 11:1-7, 12:19-23, and Figure 4.

That the printer is a hot-stamp printer, a laser printer, an ink-jet printer, or a flexographic printer is supported by at least 12:27-29.

That the first period of time is one day is supported by at least 2:24-26 and 7:20-23.

V. Conclusion

As argued above, Applicants respectfully submit that the Heiden reference is not within an analogous art because it is directed to brokering advertising space on envelopes using a postage printing system. Heiden thus cannot form the basis of a § 103(a) rejection. Even if Heiden were within an analogous art, a *prima facie* case of obviousness has not been established because the combination of Heiden and Takada, either alone or in combination with any other reference of record, fails to teach a container with a bar code where the container forms part of the code, and particularly where the code comprises variable information.

Finally, a *prima facie* case of obviousness has not been established because the combination of Heiden and Takada suggests a bar code having only fixed information, and thus teaches away from Applicants' claimed invention. For at least these reasons, and those detailed above, Applicants respectfully request that the Examiner withdraw the rejections of the pending claims and allow those same claims to issue.

Respectfully submitted,

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